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In re Application of	:
Kenneth C. Cundy et al	:
Serial No.: 09/972,425	: PETITION DECISION
Filed: October 5, 2001	:
Attorney Docket No.: 033053-025	:

This is in response to the petition under 37 CFR 1.144, filed December 29, 2003, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on October 5, 2001, and contained claims 1-20. In a first Office action, mailed January 15, 2003, the examiner required an election of species to be made by applicants, and set forth some representative examples of species without limiting applicants to choosing therefrom.

Applicants replied on March 17, 2003, electing the species identified by compound 230 and identified claims 1-10 and 19-20 as reading thereon.

The examiner mailed a new Office action to applicants on May 2, 2003, acknowledging applicants election of compound 230 and then defined a subgenus of the generic compound of formula 1 by defining variables X, R¹, R², Z, M, Q^b and D'. Claims 5-10 and 19 were then examined and claims 1-4, 11-18 and 20 withdrawn from consideration as being drawn to a non-elected invention. Claims 5 and 19 were then rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claims 6-10 were objected to as containing non-elected inventions.

Applicants replied on August 4, 2003, amending claims 1, 4-10 and 19. Claims 2 and 11-17 were canceled. Replies to the rejection were made and the election of species requirement again traversed with respect to the subgeneric concept developed by the examiner.

The examiner mailed a Final Office action to applicants on September 29, 2003, responding to the traversal by stating that the claims were directed to several patentably distinct inventions and made the requirement Final. Claims 5-10 were again objected to as containing non-elected inventions and their cancellation required. The Office action was made Final.

Applicants replied on December 29, 2003, by filing this petition requesting that the requirement be withdrawn. Applicants argue that only an election of species within the genus has been required by the examiner and that the examiner has then defined applicants' inventive concept based on the elected species and has restricted examination thereto improperly based on the guidelines of M.P.E.P. 803.02. Further the examiner has not made a restriction between the compound and method claims, but has acted as if there had been and thus not examined the method claims.

DISCUSSION

Restriction practice under 35 U.S.C. 121 can be divided into two distinct parts. In the first an examiner may define independent and distinct inventions (e.g. - a composition and a method of using) claimed by an applicant and require applicant to choose between them for prosecution purposes. In the second an examiner in order to determine a proper starting point for examination of related, but distinct, inventions (those encompassed by a generic description) may require an election of species. In some instances, the two procedures may be cumulative wherein a election between distinct inventions (e.g. - a compound and a method of using the compound) is made and then an election of species required within the elected group because of the plethora of species claimed within a genus. Specific guidelines are set forth for each type of requirement as well as guidelines for an examiner's action following election from either type of requirement.

In this instance, although the examiner alleges in the last Office action that there are a number of patentably distinct inventions claimed, no formal restriction requirement has been made between them. The examiner has required only an election of species within the compounds set forth in the claims. As such the examiner is required to follow the guidelines set forth in M.P.E.P. 803.02. To some extent the examiner has done that by examining the elected species and determining that it is free of the prior art and has then expanded the search and examination of the species to a number of related species, also finding them free of the prior art. Where the examiner has erred is in then deciding that all applicants are entitled to is the species or subgeneric concept developed from the species by the examiner which has actually been examined. This is not in accord with *In re Weber* and other cases cited in M.P.E.P. 803.02. M.P.E.P. 803.02 requires the examiner after finding the elected species to be patentable to conduct an examination of a representative number of related species and then, if the examined species are also found to be free of the prior art to allow the entire genus. This the examiner has not done.

The examiner has indicated that method claim 1, if limited to the same scope as the compound claims, would also be considered allowable, but has as yet declined to allow such claims since claim 5 remains objected to. However, no formal restriction between the method and compound claims has been made and both types of claims must therefor be examined.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for further consideration not inconsistent with this decision.

As a consequence of this decision the last Office action is withdrawn and the examiner directed to issue a new Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in cursive script, appearing to read "Joseph P. Chambers".

Bruce M. Kisliuk
Director, Technology Center 1600